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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,361	07/10/2000	Jay S. Walker	96-139XX	9450
22927	7590	11/10/2003	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 11/10/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/613,361

Applicant(s)

WALKER ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-79 is/are pending in the application.
- 4a) Of the above claim(s) 26,28 and 80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 26, 28, and 70-80 are pending in this communication filed 07/10/00 entered as Pre Amendment A, paper no. 3.
2. The IDS filed 07/10/00 is missing from the application file.
3. The Change of Address filed 11/29/00 has been entered as paper no. 5.

Election/Restriction

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 26, 28, and 80 are drawn to a method for redeeming a gift certificate, classified in class 705, subclass 50.

II, Claims 70-75 are drawn to a method for issuing a gift certificate, classified in class 705, subclass 39 and claims 76-79 are drawn to a system for issuing a gift certificate, classified in class 705, subclass 39.

5. Inventions I and II, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as producing and issuing a gift certificate with a gift certificate identifier. See MPEP 806.05(d).

6. During a telephone conversation with Attorney Michael Downs on July 16, 2003, a provisional election was made without traverse to prosecute the invention of Group II, claims 70-75 (a method for issuing a gift certificate and claims 76-79 a system for issuing a gift certificate). Affirmation of this election must be made by Applicant in responding to this Office Action. Claims 26, 28, and 80, are withdrawn from further

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consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a none elected invention.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes is indicated is proper.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 70-79 are rejected under 35 U.S.C. 102(a) as being anticipated by (US 5,909,673) Gregory.

With respect to claims 70, 73, 76, 77, 78, and 79, Gregory teaches, A method for issuing a gift certificate corresponding to a financial account, comprising the steps of: generating a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier (col. 5, lines 64-67 and col. 6, lines 1-17); producing a gift certificate including thereon said certificate identifier (col. 6, lines 31-39); and distributing said gift certificate to an owner of said financial account (col. 5, lines 56-63).

With respect to claims 73, 77, and 79 Gregory further teaches, distributing said gift certificate to a recipient (col. 10, lines 21-32).

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With respect to claims 71 and 74, Gregory teaches, The method of claim 70 wherein the financial account identifier cannot be discerned from the gift certificate identifier by a third party (col. 6, lines 18-22 and lines 31-39 and col. 8, lines 45-53).

With respect to claims 72 and 75, Gregory teaches, The method of claim 70, further including the steps of: receiving an indication of a gift certificate redemption (col. 9, lines 50-59); and updating stored account data to reflect the redemption (col. 10, lines 46-55).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Small (US 5,513,117) disclosed personalized greeting cards and gifts.

Spector (US 5,870,718) disclosed greeting and gift certificate cards.

Veeneman et al (WO 92/15968) disclosed generating gift certificates.

Hayashi (US 4,809,837) disclosed a vending machine for use with a gift certificate.

Gaines (US 5,437,478) disclosed a gift card with a receipt.

CardEX disclosed electronic gift certificates (giftcards).

American Express Gift Cheques disclosed giving American Express Gift Cheques.

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Inquiries

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



E. Colbert

November 1, 2003